

REMARKS

In response to the Office Action dated June 17, 2008, the Applicant has amended claims 1, 11 and 21. Since claims 27-28 and 35-40 were previously cancelled, claims 1-26 and 29-34 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-10, 21-26 and 29-34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Satomi et al. (U.S. Patent Publication No. 2004/0039641) in view of Petrecca et al. (U.S. Patent No. 5,781,894). The Office Action rejected claims 11-20 under 35 U.S.C. § 102(e) as allegedly being anticipated by Satomi.

The Applicants respectfully traverse these rejections based on the amendments to the claims and the arguments below.

Specifically, in light of the amendments to the claims, clearly, Satomi et al., when considered alone or in combination with Petrecca et al., are missing the **newly** added features as specifically claimed. For example, the cited references, alone or in combination, merely disclose advertising on personal computers (see Abstract of Petrecca et al.) and adding advertisement information to desired information for printing (see Abstract of Satomi et al.).

In contrast, all of the Applicant's independent claims now include automatically presenting the advertisement to the customer **while the customer interacts with the interface with an input device** to generate the job ticket. Support for these amendments can be found throughout the specification, and in particular, FIG. 5 and paragraph [0047] of the Applicant's published patent application, U.S. Patent Publication No. 2002/0082909.

Although Petrecca et al. disclose enabling sponsors to present advertisements to a user on the user's personal computer, the advertisements are presented **during periods of waiting-time** (see Abstract of Petrecca et al.). This is unlike the Applicant's newly amended independent claims, which presents the advertisement to the customer **while the customer interacts with the interface with an input device** to generate the job ticket and **not** *during periods of waiting-time*, like in Petrecca et al. Therefore, with

regard to the obviousness rejection of claims 1-10, 21-26 and 29-34, when Satomi et al. is combined with Petecca, the combination still does **not** disclose, teach or suggest all of the features of any of the amended independent claims. Moreover, with regard to the anticipation rejection of claims 11-20, since Satomi et al. is **missing** all of the features of the Applicant's newly amended independent claims, Satomi et al. **cannot** anticipate these claims. Hence, the Applicant submits that all of the rejections should be withdrawn.

Further, even though the combined references do not disclose, teach, or suggest the Applicant's claimed invention, the references should **not** be considered together because Petrecca et al. **teaches away** from the Applicant's claimed invention. For example, Petrecca et al. **explicitly** discloses an "...advertising system to be used with personal computers which enables sponsors to present advertisements or commercials to a user ***during periods of waiting-time...***" [*emphasis added*]. However, the present invention automatically presents the advertisement to the customer **while the customer interacts with the interface with an input device** to generate the job ticket. Unquestionably, Petrecca et al. **cannot** do what the Applicant's invention does because Petrecca et al. **requires** advertisements to be presented when the input device or keyboard is **not** being used and ***during periods of waiting-time***.

Hence, if Petrecca et al. were modified to automatically present advertisements to the customer **while the customer interacts with the interface with an input device**, like in the Applicant's independent claims, the proposed modification would render Petrecca et al. being modified **unsatisfactory for its intended purpose** and would change the principle of operation of the invention in Petrecca et al. being modified. This is because Petrecca et al. **explicitly require** the advertising to be presented to the user ***during periods of waiting-time***, such as when the user is not ***able to use the keyboard of the computer***, in direct contrast and conflict with the independent claims of the present invention. Clearly, the spirit and the main objects and goals of the invention in Petrecca et al. are to provide advertisements "during the waiting period" of computer events (see Abstract and Summary of Petrecca et al.), in contract to the Applicant's claimed invention.

As such, since the Applicant's claimed elements are not disclosed, taught or suggested by the combined references and because Petrecca et al. teach away from the Applicant's invention, Petrecca et al. cannot be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. *MPEP 2143*.

Last, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicant in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicant's claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly **requests** the Examiner to telephone the Applicant's attorney at **(818) 885-1575**.

Please note that all mail correspondence should continue to be directed to:

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